REMARKS

The Examiner has rejected Claims 1, 3, 5-6, 8-10, 15-16, 19-20, 25-26, 28-29, 31 and 33-38 under 35 U.S.C. 103(a) as being unpatentable over Odagiri (U.S. Patent Application Publication No. 2001/0007817) in view of Henrie (U.S. Patent No. 6,804,699) in further view of Uppunda (U.S. Patent No. 6,678,728). In addition, the Examiner has rejected Claims 14 and 24 under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Uppunda in further view of Parker (U.S. Patent Application No. 2002/0078393). Applicant respectfully disagrees with such rejections, especially in view of the amendments made to each of the independent claims.

With respect to independent Claims 1 et al. and 16 et al., the Examiner has relied on the following excerpts from Henrie and Uppunda to make a prior art showing of applicant's claimed technique "wherein when the device is at least partially non-functional, the device is configured to continue periodically sending the identifying signal to the control unit" (see the same, or substantially similar, claim language in Claims 1 and 29), and "wherein after the generation of the alarm, the second Bluetooth-enabled device is configured to continue periodically emitting the first Bluetooth transmission signal to the first Bluetooth-enabled device" (see the same, or substantially similar, claim language in Claims 16 and 26):

> "Alternatively, Web site 40 can respond to portable computer system 100 with an indication that the device is not lost or stolen, where this indication is necessary in order for portable computer system 100 to operate normally. In one embodiment, the user can configure portable computer system 100 such that it is necessary for the device to make contact with Web site 40 on a periodic basis, at an interval specified according to user preferences. If the specified time period expires before portable computer system 100 connects with Web site 40, then the device is automatically disabled. For example, the authorized user could specify that portable computer system 100 is to connect with Web site 40 once per week, and if a week goes by without such a connection, then portable computer system 100 is disabled. If, at a later time, the authorized user attempts to use portable computer system 100, then portable computer system 100 can still be connected to Web site 40 (this capability remains even if the device is in the disabled or locked mode). After looking up the account information based on the unique identity of portable

computer system 100 (step 945) to determine whether the device has been lost or stolen, Web site 40 sends a signal to the device that unlocks the device and enables normal operation. It is appreciated that other actions may need to be performed in order to re-enable operation of the device.

In step 960, if portable computer system 100 is reported as lost or stolen, then Web site 40 sends a signal to the device indicating that normal operation of the device is disabled. As described above, disabling operability of the device can be the result of a signal received from Web site 40 or it can be a default setting if no response is received to the signal of step 930. In addition, if portable computer system 100 has been reported as lost or stolen and has already been disabled in accordance with the present invention, it will continue to remain disabled as a result of this step. For example, if portable computer system 100 is in the locked mode, and no response is received in step 960, then it will continue to remain in the locked mode." (Henrie as applied to Claims 16 and 26-Col. 11, lines 28-65-emphasis added)

"If a device has not been active in receiving or transmitting data for some period, such as when the device is powered down (in a "sleep" state), the device may be removed from the routing table. When a device is removed from the routing table, the router that removed it no longer knows the device exists. To prevent this from occurring, some network devices periodically transmit data over the network to inform other network devices that they are still on the network. The data may be so-called "keep-alive" packets formatted according to a predetermined protocol.

One way of using keep-alive packets is to store the packets in a transmit first-in-first-out (FIFO) buffer that is used for staging data to be transmitted over the network. The keep-alive packets are periodically transmitted when the network device is in a sleep state." (Uppunda as applied to Claims 1, 16, 26 and 29-Col. 1,lines 20-34)

Applicant respectfully asserts that the above excerpt from Henrie does not meet applicant's above cited claim language, and in fact *teaches away* from applicant's claim language. Specifically, Henrie teaches "that it is necessary for the device to make contact with Web site 40 on a periodic basis...If the specified time period expires before portable computer system 100 connects with Web site 40, then the device is automatically disabled." (see emphasized excerpt above) Thereafter, only when "the authorized user attempts to use portable computer system 100, then portable computer system 100 can still be connected to Web site 40..." (see emphasized excerpt above)

Thus, in Henrie, when the portable computer system does not connect to the web site within a specified period of time at periodic intervals, the system is disabled, and the portable computer system can only connect to the Web site when an authorized user attempts to use the portable computer system. Applicant, on the other hand, claims continuing to periodically send identifying signals to the control unit even when the device is partially locked out, as in the following claim language: "wherein the first Bluetooth-enabled device periodically emits the first Bluetooth transmission signal while being locked out." Therefore, Henrie clearly *teaches away* from applicant's claim language.

After careful review of the above excerpt from Uppunda relied on by the Examiner, it seems the Examiner has failed to consider the full context of applicant's claims. In particular, applicant claims that "when it is determined that the device is not within the range of communications of the control unit, the device is at least partially non-functional" (emphasis added-Claims 1 and 29) and "generating an alarm to indicate that the second...device is not within a communications range of the first...device" (emphasis added-Claims 16 and 26). Thus, when read in the context of applicant's remaining claim language, when the device is out of a communications range, "the device is configured to continue periodically sending the identifying signal to the control unit."

Uppunda, on the other hand, simply teaches that when the "device has not been active...for some period....[the device] periodically transmit[s] data over the network to inform other network devices that they are still on the network" (emphasis added-see emphasized excerpt above). Clearly, Uppunda teaches a situation where the device is still in a communications range of the network, since it must be in communication with the network to periodically transmit data over the network. To emphasize this, Uppunda even continually discloses the device being in a "sleep" state, and not that the "device is at least partially non-functional," in the context claimed by applicant, namely when "the device is not within the range of communications of the control unit."

In the latest Office Action dated 11/7/2005, the Examiner has argued that applicant's claimed limitation reads on a system where a device periodically sending an identifying signal in range of communications may go into a sleep mode or powered down mode in which it is at least partially non-functional and in which it is configured to continue to periodically send an identifying signal. Specifically, the Examiner has argued that applicant's claimed "when it is determined that the device is not within the range of communications of the control unit, the device is at least partially non-functional" does not necessarily mean that if the device is at least partially non-functional, the device is out of range of communications with the control unit.

Applicant respectfully disagrees. In particular, in the claims, applicant has defined the device as being at least partially non-functional, when it is determined that the device is not within the range of communications of the control unit. Thus, by its claimed definition, when read in context, it is required that "when the device is at least partially non-functional [such that it is not within the range of communications of the control unit], the device is configured to continue periodically sending the identifying signal to the control unit." Nevertheless, despite such paramount deficiency and in the spirit of expediting the prosecution of the present application, applicant has amended the claims to more explicitly require what was previously, at the very lease, implicit.

With respect to independent Claims 10 and 20, the Examiner has again relied on Col. 1, lines 20-34 in Uppunda as cited above to make a prior art showing of applicant's claimed "locking out the first Bluetooth-enabled device to at least partially prevent the first Bluetooth-enabled device from functioning if it is determined that the second Bluetooth transmission signal is not received, wherein the first Bluetooth-enabled device periodically emits the first Bluetooth transmission signal while being locked out" (see the same or similar, but not identical language in each of the foregoing claims).

First, applicant respectfully asserts that nowhere in the excerpt from Uppunda relied on by the Examiner is there even a suggestion of "locking out the...device," as claimed by applicant. Uppunda only generally relates to when "a device has not been

active in receiving or transmitting data for some period, such as when the device is powered down." However, nowhere does Uppunda teach locking out the device, and especially not when "it is determined that the second Bluetooth transmission signal is not received," in the context claimed by applicant.

In the latest Office Action dated 11/7/2005, the Examiner has stated that applicant has misinterpreted the rejection and that Henrie teaches applicant's claimed "locking out the first Bluetooth-enabled device to at least partially prevent the first Bluetooth-enabled device from functioning if it is determined that the second Bluetooth transmission signal is not received, wherein the first Bluetooth-enabled device periodically emits the first Bluetooth transmission signal while being locked out" (see the same or similar, but not identical language in each of the foregoing claims). The Examiner has specifically relied on Col. 11, lines 42-65 in Henrie to meet applicant's specific claim language.

Applicant respectfully asserts that the except relied on by the Examiner simply discloses that "it is necessary for the device to make contact with Web site 40 on a periodic basis...[and that i]f the specified time period expires before portable computer system 100 connects with Web site 40, then the device is automatically disabled" (Col. 11, lines 28-52). Applicant, on the other hand claims that "it is determined that the second Bluetooth transmission signal is not received" where the "second Bluetooth transmission signal is received from the second Bluetooth-enabled device." Thus, in Henrie the device is disabled if the device itself does not make contact with the web site, whereas applicant claims locking out the first Bluetooth-enabled device if the second Bluetooth transmission signal is not received at the first Bluetooth-enabled device from the second Bluetooth-enabled device.

Furthermore, Henrie does not disclose that "the first Bluetooth-enabled device periodically emits the first Bluetooth transmission signal while being locked out." In fact, applicant notes that Henrie only teaches that after the device is automatically disabled and "the authorized user attempts to use portable computer system 100, then portable computer system 100 can still be connected to Web site 40." Thus, Henrie

merely discloses connecting to the web site by user authorization, and not "periodically emit[ting] the first Bluetooth transmission signal while being locked out," as claimed by applicant (emphasis added).

Still with respect to each of the independent claims, the Examiner has relied on paragraph [0013] in Odagiri to make a prior art showing of applicant's claimed technique "wherein the control unit is configured to produce an alert when it is determined that the device is not within the range of communications of the control unit" (see the same or similar, but not necessarily identical language in each of the independent claims). After careful review of such excerpt and the entire Odagiri reference, applicant notes that Odagiri actually *teaches away* from applicant's claimed technique. Specifically, paragraph [0013] discloses "performing alerting with respect to the reception of the signal" (emphasis added). To further emphasize, Odagiri teaches that "[w]hen the first receiving section 401 receives a signal, the alert section 405 informs the possessor (user) of the reception of the signal by the first receiving section 401..." (see paragraph [0063] and item 405 of Figure 4). Thus, Odagiri only teaches performing an alert upon reception of a signal, and not "when it is determined that the device is not within the range of communications of the control unit," as specifically claimed by applicant (emphasis added).

In addition, in Odagiri it is the receiving device that performs the alert in order to inform the user of the device of the reception. Applicant, on the other hand, claims, in at least a portion of the claims, that "the control unit is configured to produce an alert" (emphasis added), and not merely the receiving device, as in Odagiri.

In the latest Office Action dated 11/7/2005, the Examiner has argued that the excerpt relied upon teaches that "[t]he decision section 404 makes a determination as to whether the reply signal is received by the receiving section..." and that "[w]hen the first receiving section 401 receives a signal, the alert section 405 informs the possessor (user) of the reception of the signal by the first receiving section 401 depending upon the result of the determination made by the decision section 404." The Examiner has also referred to Figure 4 in Odagiri to meet applicant's claim language.

Applicant again respectfully asserts that Odagiri expressly discloses only producing an alert "[w]hen the first receiving section 401 receives a signal" (emphasis added). Applicant emphasizes that the decision section 404 in Odagiri only "makes a determination as to whether the reply signal is received" and that the "alert section 405 informs the possessor (user) of the reception of the signal by the first receiving section 401 depending upon the result of the determination made by the decision section 404" (emphasis added). Thus, the alert is only produced upon reception of the signal in accordance with the determination that the signal was received which is made by the decision section. Simply nowhere does Odagiri teach producing an alert regardless of the determination made by the decision section, as the Examiner seems to contend.

Furthermore, the Examiner's reference to the rejection of Claim 1 in responding to applicant's arguments that Odagiri does not teach that "the control unit is configured to produce an alert" (emphasis added) is also deficient. Specifically, with respect to the rejection of Claim 1, the Examiner has relied on paragraph [0013] in Odagiri to meet applicant's claim limitation that "the control unit is configured to produce an alert." However, such excerpt only generally teaches "performing alerting with respect to the reception of the signal by the first receiving means" (emphasis added). Applicant points out that Odagiri expands on this technique in paragraph [0063] in which Odagiri expressly discloses that it is the alert section which "informs the possessor (user) of the reception of the signal" is located within the information processor of the portable device (see paragraph [0060]), which clearly does not meet a control unit that is configured to produce an alert, in the manner claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has at least substantially incorporated the subject matter of Claims 8 and 9 et al. into each of the independent claims.

With respect to Claim 8 et al., presently incorporated substantially into each of the independent claims, the Examiner has relied on paragraph [0013] in Odagiri along with Col. 12, lines 8-12 in Henrie to make a prior art showing of applicant's claimed technique "wherein the control unit includes a control unit display, the control unit display being configured to display information associated with the device when it is determined that the device is not within the range of communications of the control unit."

Applicant respectfully asserts that Odagiri only teaches performing an alert upon reception of a signal, and not "when it is determined that the device is not within the range of communications of the control unit" as specifically claimed by applicant (emphasis added). Furthermore, the excerpt from Henrie relied on by the Examiner teaches that the "information for identifying and contacting the authorized owner or user is displayed on display device 105 (FIG. 5) of portable computer system 100 when the device is in the disabled (locked) mode of operation." Thus, the information in Henrie is displayed on the device, and not on a display of the control unit, in the manner claimed by applicant.

In the latest Office Action dated 11/7/2005, the Examiner has failed to respond to applicant's arguments. Thus, applicant respectfully requests a notice of allowance or a proper prior art showing of such specific claim language.

With respect to Claim 9 et al., presently incorporated substantially into each of the independent claims, the Examiner has again relied on paragraph [0013] in Odagiri along with Col. 12, lines 8-12 in Henrie to make a prior art showing of applicant's claimed technique "wherein the device includes a device display, the device display being configured to display information associated with the control unit when it is determined that the device is not within the range of communications of the control unit."

The Examiner has stated that "Odagiri discloses the idea of alerting a user when it is determined that the device is not within range of communications of the control unit." However, as argued above with respect to Claim 7 et al., Odagiri only teaches performing an alert upon reception of a signal, and not "when it is determined that the device is not within the range of communications of the control unit," as specifically claimed by applicant (emphasis added). Furthermore, the excerpt from Henrie relied on by the Examiner only teaches displaying "information for identifying and contacting the authorized owner or user [of the device]" (emphasis added). Clearly, displaying information associated with an owner/user of the device does not meet applicant's specifically claimed "display[ing] information associated with the control unit" (emphasis added).

In the latest Office Action dated 11/7/2005, the Examiner has argued that he fails to see how the owner of the device is not associated with the control unit. Applicant respectfully asserts that, as claimed, "the device is registered with the control unit such that the device cooperates with the control unit using Bluetooth communications to determine when the device is within the range of communications of the control unit" (see Claim 1 et al.). Thus, the device is separate from the control unit. Since Odagiri only teaches a user of the device, and not of the control unit, "information for identifying and contacting the authorized owner or user" does not meet applicant's claimed "information associated with the control unit" (emphasis added).

Since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

Reconsideration is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. Applicants are enclosing a check to pay for the added claims. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P312/01.048.02).

Respectfully submitted,
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